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Date: 26 November 2002

To: Examiner Lauren Q. Wells
US Patent and Trademark Office
Tel. 703-308-1234
Fax: 703-872-9306

Subject: USSN 09/577,294
Our Ref.: Beiersdorf 614-HCL

From: Howard C. Lee

Comments: Filing of Petition for Requirement of Restriction Under 37 CFR 1.144 (4 pgs.)

If you have any questions or need further information, please contact us.

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Beiersdorf 614.1-HCL
6713-Dr. Wi-ka

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: BLECKMANN et al.

SERIAL NO.: 09/577,294

FILED: 23 May 2000

FOR: PREPARATIONS OF THE W/O EMULSION TYPE WITH AN
INCREASED WATER CONTENT, COMPRISING MODERATELY
POLAR LIPIDS AND SILICONE EMULSIFIERS AND, IF DESIRED,
CATIONIC POLYMERS

ART UNIT: 1619

EXAMINER: Lauren Q. Wells

26 November 2002

Technology Center 1600/2900
Group Director 1610 (John Doll)
Hon. Commissioner of Patents
Washington, D.C. 20231

Petition for Requirement of Restriction Under 37 CFR 1.144

SIR:

In response to the finality of the restriction and election of species requirement issued by the examiner in Paper No. 20 dated 17 October 2002, please accept this petition to reconsider the restriction requirement of Paper No. 18 dated 2 July 2002.

CONDITIONAL PETITION FOR EXTENSION OF TIME

If entry and consideration of the amendments above requires an extension of time, Applicants respectfully request that this be considered a petition therefor. The Assistant Commissioner is authorized to charge any fee(s) due in this connection to Deposit Account No. 14-1263.

ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

Beiersdorf 614.1-HCL
6713-Dr. WI-ka**REMARKS****History of Restriction Requirement and Response**

The table below highlights the prosecution history of Application SN: 09/577,294:

ACTION TAKEN	ACTION DATE
Application filed	23 May 2000
First office action on the merits mailed (Paper No. 5)	30 January 2001
Response to first action mailed	30 July 2001
Final rejection mailed (Paper No. 10)	9 September 2001
Response to final rejection and Notice of Appeal filed	26 February 2002
Advisory Action mailed (Paper No. 15)	22 March 2002
CPA filed	26 April 2002
Restriction/Election of Species mailed	2 July 2002
Response to Restriction/Election of Species	23 July 2002
First office action on the merits – Restriction made final	17 October 2002

Standard for Establishing Basis for Restriction

MPEP 803 ("Restriction – When Proper") states criteria which includes that:

- (1) The inventions must be independent or distinct as claimed; **AND**
- (2) There must be a serious burden on the examiner if restriction is required.

MPEP 803 also states that "If the search and examination of an entire application can be made without serious burden, the examiner **must examine it on the merits**, even though it include claims to independent or distinct inventions."

MPEP 803 also teaches as a guideline for practice that "Examiners **must provide reasons and/or examples to support conclusions**, but need not cite documents to support the requirement in most cases." With respect to the serious burden requirement, it is stated that "... (serious burden) may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art or a different field of search as defined in MPEP § 808.02."

Actions by Examiner Appear to Provide Prima Facie Evidence the Applicants Claims Provided No Serious Burden on the Examiner

The application as originally filed was not subject to a restriction/election of species requirement and in fact received two office actions on the merits prior to the filing of the CPA application which were affirmed/signed by two different primary examiners (Ms. Diana Dudash (then SPE of Art Unit 1619, now a Quality Assurance specialist for Tech Center 1600/2900) and Ms. Dameron Jones). This would appear to be *prima facie* evidence that there was not undue burden in the examination of this application. Such that it could be argued that the applicants' amendments substantially altered the nature or scope of the invention, this is not the case for this application.

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The amendment of 30 July made mainly clerical changes to the claims to place them in closer conformance with U.S. practice (no change in the scope of the claims was intended); the examiner's next response was a final rejection with no suggestion that a restriction/election of species would be forthcoming.

The amendments of 26 February (introduction of the limitation "having a viscosity at 25° C which is less than 5000 mPa.s" to claim 1) and 28 February 2002 (clerical amendment) were denied entry as indicated in the Advisory Action. Again, this action did not indicate that entry of the amendment would require a restriction/election of species requirement.

Concurrent with the filing of the CPA was a request to enter the previously unentered amendments of 26 and 28 February which was granted by the PTO. Therefore, the claims which were pending at the time the restriction/election of species requirement was drafted by the examiner were actually *narrower* than the claims which were examined on the merits prior to the filing of the CPA.

If there is a reason why the pending claims now constitute an undue burden on the examiner, they have not been disclosed by the examiner (especially in light of the fact that the examiner previously did not hold the claims to constitute an undue burden and that this position was confirmed by two different primary examiners which included a SPE (and current QA specialist).)

No Reasons for Insisting Upon Restriction as Required by MPEP 808

MPEP 808 states that "Every requirement to restrict has two aspects:

- (A) the reasons (as distinguished from the mere statement of conclusion) why the invention *as claimed* are either independent or distinct; and
- (B) the reasons for insisting upon restriction therebetween as set forth in the following sections."

MPEP 808.01(a) states that "***Where there is no disclosure of relationship between species*** (see MPEP § 806.04(b)), they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner."

However, ***the examiner herself acknowledges a relationship between the species*** when drafting her election requirement (see pages 2-3 of examiner's election/restriction requirement: "Possible lipids, emulsifiers, and lipophilic constituents include..." (page 2, line 7); "Possible cationic polymers include..." (lines 13-14); "Possible water-soluble substances include..." (third to last line); "Possible interface-active substances include..." (page 3, lines 2-3).

No Restriction Was Required in Applications Alleged to Cause Present Application to Be Unpatentable by Virtue of Obviousness-Type Double Patenting

While the applicants disagree with the examiners' holding of obviousness-type double patenting, from the examiner's perspective the claims of SN: 09/328,727 (Examiner Choi and Primary Examiner Pak); SN: 09/428,421 (Primary Examiner Metzmaier); and SN: 09/963,161 are not patentably distinct from the present application. However, neither the '727 nor the '421 applications were subject to a restriction during the prosecution of these applications (as of this date, the applicants are unaware of any action for

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the '161 application). As such, three primary examiners and two junior examiners (not including the present examiner) have determined that no restriction was required for subject matter which is deemed to be not patentably distinct by the examiner.

Summary

For the reasons given above, it is believed that there is no basis for the restriction/election of species requirement by the examiner which was mailed on 2 July 2002. It respectfully requested that the restriction/election of species requirement be withdrawn and that a new first office action on the merits be submitted if the claims are not held to be allowable by the examiner.

Closing

A favorable decision on this petition is respectfully requested. If any further information is needed, please feel free to contact the undersigned at the telephone number below.

Respectfully submitted,

NORRIS MCLAUGHLIN & MARCUS, P.A.

By

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HCL:vif

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Petition for Requirement of Restriction Under 37 CFR 1.144 (4 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: 26 November 2002

By:

Vilma I. Fernandez
Vilma I. Fernandez